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Attorney Docket No. 1793.1098

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Tae-Hee LEE

Confirmation No.: 2278

Application No.: 10/765,876

Group Art Unit: 4134

Filed: January 29, 2004

Examiner: Asher R. KHAN

For: APPARATUS AND METHOD FOR PLAYING OPTICAL DISK

**PETITION FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION AND  
PETITION TO RESET A PERIOD FOR REPLY UNDER MPEP §710.06**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

In a non-final Office Action mailed March 18, 2008, Claims 1-6 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent Application No. 2004/0001704 by Chan et al. ("Chan") in view of the Abstract of Korean Patent Publication No. P1997-0029482 by Jin Yong Bang ("Bang Abstract").

Applicants traversed the Office Action without amending the claims in an Amendment filed on April 22, 2008. In the Amendment, Applicants argued the rejection of the claims based on the Bang Abstract alone is improper. Applicants further requested the Examiner provide a translation of Bang and that the Examiner specifically provide support for the rejection from the underlying specification of Bang rather than the Bang Abstract in a non-Final Office Action, so that Applicants were provided the opportunity to respond to the rejection.

In a Final Office Action mailed June 6, 2008, the claims were again rejected under 35 U.S.C. 103(a) as being obvious over Chan and Bang Abstract. Although a translation of Bang was provided, the Office Action continues to refer to Bang Abstract in support of the rejections, as seen on page 3 of the Final Office Action. There, the rejection appears to be a verbatim repetition of the rejection set forth in the March 18, 2008 Office Action.

## REJECTION BASED ON ABSTRACT IS IMPROPER / EXAMINER NOT RESPONDING

As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Moreover, and as previously argued in the Amendment filed on April 22, 2008, the rejection of the claims based on Bang Abstract without citation of and reliance upon the underlying document is improper (see MPEP § 706.02, part II). In the same Amendment, Applicants requested that a new non-Final Office Action be issued so that Applicants were afforded the opportunity to reply to a rejection based on Bang and not the Bang Abstract before issuance of a final Office Action.

Accordingly, both the non-final Office Action mailed March 18, 2008 and the Final Office Action mailed June 6, 2008 are improper and Applicants respectfully request that a new non-Final Office Action be issued. Any rejections should further refer to the underlying Bang document rather than to the Bang Abstract.

## THE EXAMINER HAS INTRODUCED A NEW GROUND FOR REJECTION

As noted in at least MPEP 706.07(a), under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In a non-Final Office Action dated March 18, 2008, claims 1-6 were rejected under 35 U.S.C. 103(a) as being obvious over under 35 U.S.C. 103(a) as being obvious over U.S. Patent Chan in view of the Bang Abstract. Applicants alternatively argue that in the current Final Office Action mailed June 6, 2008, claims 1-6 are rejected under 35 U.S.C. 103(a) as being obvious over Chan in view of Bang (rather than the Bang Abstract.)

Applicants did not amend the claims in response to the non-Final Office Action dated March 18, 2008, nor was the Final Office Action mailed June 6, 2008 based on information submitted by the Applicants in an IDS.

Accordingly, because the Examiner has introduced a new ground for rejection that was neither necessitated by Applicants' amendment of the claims nor based on information submitted

in an IDS, Applicants respectfully request withdrawal of the finality of the Office Action.

#### REJECTION BASED ON INHERENCY IS INSUFFICIENT AND THUS IN ERROR

The Final Office Action mailed June 6, 2008 asserts that limitations or properties of the Bang disclosure are inherent without establishing any basis for the assertion. MPEP 2112 IV states in part:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Applicants assert that the current Office Action fails to provide the objective evidence and technical reasoning necessary to support such a conclusion of inherency. For example, the Office Action bases its rejection of claim 1 at page 7, lines 5-6, on the following conclusion of inherency:

“It is inherent that the videotape or DVD(optical disk) having [sic] tracks.”

If such an assertion of inherency is to be relied upon in any future Office Action, Applicants respectfully request the rejection provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied reference, as required by MPEP 2112 IV. Further, a new non-Final Office Action should be issued in place of the current Final Office Action to correct the noted error and to give Applicants an opportunity to review the Office’s position as to these arguments and to clarify the record for appeal.

#### REQUEST TO RESET THE PERIOD OF REPLY

MPEP §710.06 states the following regarding a request to reset the period of reply:

Where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant.

Accordingly, based on the errors set forth in this response, Applicants respectfully request the Office to issue a new non-final Office Action and to reset the required period of reply.

Respectfully submitted,

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